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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,819	05/03/2001	Richard T. Allen	ACS 57527	8480

24201 7590 10/03/2002

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EXAMINER	
MATTHEWS, WILLIAM H	
ART UNIT	PAPER NUMBER

3738

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary	Application No.	Applicant(s)
	09/848,819	ALLEN ET AL.
	Examiner	Art Unit
	William H. Matthews (Howie)	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,7-9,12-14,20,22 and 23 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4,6,10,11,15-19 and 21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input checked="" type="checkbox"/> Other: <u>3 sheets of drawings with 9/30/02</u> |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-21, drawn to stents, classified in class 623, subclass 1.15.
 - II. Claims 22-23, drawn to method of making a stent, classified in class 216, subclass 10.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed could be made by a materially different process such as chemical etching.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Should Applicant elect Group I drawn to stents, then a further election of species must be made as described below:
5. This application contains claims directed to the following patentably distinct species of the claimed invention:

A. Figure 7A	H. Figure 7H
B. Figure 7B	I. Figure 7I

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- | | |
|--------------------|----------------|
| C. Figure 7C and 8 | J. Figure 7J |
| D. Figure 7D | K. Figure 7K |
| E. Figure 7E | L. Figure 7L |
| F. Figure 7F | M. Figure 9 |
| G. Figure 7G | N. Figures 4-6 |

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Gunther Hanke on September 30, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21 and furthermore to prosecute species C (figures 7C and 8) drawn to claims 1,2,4,6,10,11,15-19, and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3,5,7-9,12-14,20, and 22-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

8. The information disclosure statement filed August 15, 2002 has been placed in the application file, but some of the information referred to therein has not been considered as to the merits. Specifically the "Foreign Patent Documents" and "Other Documents" on pages 1-4 of the information disclosure statement were not considered at this time because the parent application was unavailable at the time of examination.

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Should the parent application continue to be unavailable the Examiner may request Applicant to furnish copies of these documents.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1,2,4,6,10,11,15,16,18,19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmaz US PN 5,102,417.

See the attached sheet specifically showing location of the cylindrical rings, reinforcing members, and interconnecting members in figure 10. Also see lines 3-18 of column 7 and the abstract. Regarding claim 4, the interconnecting member connects a reinforcing member of a valley to a valley of an adjacent cylindrical ring.

11. Claims 1,2,6,11,15-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Milo US PN 6,206,911.

See the attached sheet specifically showing location of the cylindrical rings, reinforcing members, and interconnecting members in figure 1. Also see lines 26-54 of col. 3 and line 65 of col. 5 through line 52 of col. 6.

12. Claims 1,2,4,11,15,16,18,19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Killion US PN 5,868,781.

See the attached sheet specifically showing location of the cylindrical rings, reinforcing members, and interconnecting members in figure 4B. Also see lines 16-27 of column 5.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palmaz US PN 5,102,417 in view of Bley et al. US PN 5,674,241.

Palmaz meets the limitations of claim 17 as described above but lacks the express disclosure of providing a biocompatible coating. However, Bley et al. teaches a biocompatible coating for use with any stent in order to provide a drug release function to improve the effectiveness of the stent (see lines 25-48 of column 4).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the stent disclosed by Palmaz by including a

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biocompatible coating as taught by Bley et al. in order to provide a drug release function to improve the effectiveness of the stent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 703-305-0316. The examiner can normally be reached on Mon-Fri 7:00-4:30 (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

WJM
WJM
September 30, 2002

Paul Preble
Paul B. Preble
Primary Examiner





